

**REMARKS**

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the following remarks. Claims 1-28 were pending prior to the Office Action. Withdrawn claims 8-28 have been cancelled, and claims 29-50 have been added by this Reply. Therefore, claims 1-7 and 29-50 are pending. Claims 1, 3, 31, and 42 are independent.

**Rejection under 35 U.S.C. §102(e)**

Claims 3-5 and 7 are rejected under 35 U.S.C. §102(b) as being anticipated by Hicks (U.S. Patent No. 5,359,387). It is noted that claim 4 actually depends from claim 1, and claim 1 has not been rejected over Hicks. Therefore, Applicant will treat this as a rejection of claims 3, 5, and 7 based on Hicks. As such, Applicant respectfully traverses this rejection.

For a Section 102 rejection to be proper, the cited reference must teach or suggest every claimed element. See *M.P.E.P.* 2131; *M.P.E.P.* 706.02. Thus, if a cited reference fails to teach or suggest one or more elements, the rejection is improper and must be withdrawn.

In this instance, Hicks does not teach or suggest each and every claimed element. For example, independent claim 3 recites, in part, "recording inputted order conditions and processing conditions as order information onto the image recording medium on which the

visible image is formed". Hicks fails to teach or suggest this feature.

Rather, Hicks is directed toward facilitating correlation of subjects of a photograph with a person ordering the photographs. See column 1, lines 10-20. To achieve this objective, Hicks describes printing a plurality of positive prints from photographic film and including a corresponding ordering space with each picture. See FIG. 2; column 2, lines 3-22; column 3, lines 29-36.

However, it is noted that the orderer can only specify print size and number of prints. Hicks does not contemplate allowing an orderer to specify any aspect that can even remotely be characterized as a processing condition. Thus, Hicks does not teach or suggest at least the above-noted feature of independent claim 3. Therefore, independent claim 3 is not anticipated by Hicks.

Since claims 5 and 7 depend from independent claim 3, these dependent claims are also not anticipated by Hicks for at least the reasons stated above with respect to claim 3.

Applicant respectfully requests withdrawal of the rejection of claims 3, 5, and 7 under 35 U.S.C. §102(b) based on Hicks.

**Rejection under 35 U.S.C. §102(e) based on Ueda**

Claims 1-7 stand rejected under 35 U.S.C. §102(e) as being anticipated by Ueda et al. (U.S. Patent No. 6,429,923, hereinafter "Ueda"). Applicant respectfully traverses this rejection.

As noted above, if a cited reference does not teach or suggest all claimed features, the rejection is improper and must be withdrawn.

In this instance, independent claim 1 recites, in part, "recording order information...onto...the image recording medium". Independent claim 3 recites a similar feature. Contrary to the assertion in the Office Action, Ueda fails to teach or suggest the above-recited feature of independent claims 1 and 3.

Ueda is directed to a photographic processing system, in which the main objective is to prevent others from learning the personal information of a person ordering print processing. See column 1, lines 35-45; column 2, lines 1-6. Ueda achieves this objective mainly by separating the gathering of print processing request information from personal information gathering, the former being carried out in a fairly conventional manner by having the orderer to specify his or her wishes with respect to print processing. See column 36, lines 43-52.

On the other hand, the process of gathering personal information, such as a user's address and phone number, is performed separately. For example, the user may insert a credit card into a card reader, and personal information may be determined on the basis of the credit card. See column 38, lines 10-27. Alternatively, a

user may insert a shopping chain card or a card with barcoded information thereon. See column 34, lines 7-18.

Whatever the process, Ueda requires that order information is always packaged as a header and **transmitted** to a server to be processed. See, e.g., column 37, lines 20-25; column 39, lines 23-32; column 42, lines 12-22. There is no teaching or suggestion in Ueda that header information is ever stored on an image recording medium, as recited in the presently claimed invention. Indeed, Ueda suggests the opposite, since its objective is to enhance security by separating personal information from print processing request information.

As a result, independent claims 1 and 3 are not anticipated by Ueda. Since claims 2 and 4-7 depend directly or indirectly from independent claims 1 and 3, these dependent claims are also not anticipated by Ueda for at least the reasons stated above with respect to independent claims 1 and 3.

Applicant respectfully requests withdrawal of the rejection of claims 1-7 under 35 U.S.C. §102(e) based on Ueda.

New Claims

Claims 29-50 have been added in this Reply and are believed to distinguish over the cited art, taken individually or in any combination, due to their dependence on allowable independent claims, as well as for the additional limitations provided thereby. For example, claims 29 and 30 depend from independent claims 1 and 3, respectively. Accordingly, these newly added dependent claims are patentable over the cited art for at least the reasons stated above with respect to independent claims 1 and 3.

Newly added independent claim 31 recites, in part, "recording a copy of the original image to a new recording medium" and "integrally associating the encoded order information with the new recording medium". Independent claim 42 recites a similar feature.

It has been shown above that neither Hicks nor Ueda teaches or suggests at least the above-noted features of independent claims 31 and 42. Therefore, independent claims 31 and 42, as well as claims 32-41 and 43-50 which depend from these independent claims, are patentably distinct from Hicks and Ueda.

Applicant respectfully requests that claims 29-50 be allowed.

CONCLUSION

All rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance, and such allowance is earnestly

solicited. However, should there be any outstanding matters that may be resolved by a telephone conference, the Examiner is invited to contact Hyung Sohn (Reg. No. 44,346) at 703-205-8000 in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

D. Richard Anderson  
Reg. No. 40,439

**1982-174P**  
DRA:HNS:rk.kmr

P. O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000